

### **REMARKS**

This responds to the Office Action mailed on June 28, 2005, and the references cited therewith.

Claims 25, 27 and 29 are amended, no claims are canceled, and no claims are added; as a result, claims 1-4, 9-12, 14-20, and 23-29 are now pending in this application.

#### **Claim Objections**

Claim 28 was objected to for informalities.

Claim 28 recites "wherein the gaming machine storage medium is a removable memory." The Office Action asserts that the claimed "gaming storage medium" should be corrected to "machine readable medium." Applicant submits that no correction is necessary. Applicant submits that antecedent basis for "gaming storage medium" is in parent claim 23.

#### **§112 Rejection of the Claims**

Claims 25 and 29 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement.

Applicant has amended claim 25 to recite "wherein the receiving and the disabling are performed by a write-protection device connected to an interface of the removable memory."

Applicant has amended claim 29 to recite "a write-protection device for preventing a write operation to the removable storage medium."

Support for these amendments can be found in the instant application *inter alia* at Page 8, Line 32 – Page 9, Line 2.

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Applicant has amended claim 27.

#### **§103 Rejection of the Claims**

Claims 1-4, 9-12, 14-20 and 23-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ozeki et al. (U.S. 5,402,385; hereinafter referred to as Ozeki) in view of

Helmbold et al. (U.S. 5,497,450; hereinafter referred to as Helmbold) and Yokouchi (U.S. 5,802,332; hereinafter referred to as Yokouchi).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant submits that the Office Action has not established a *prima facie* case of obvious because the cited references are nonanalogous art, because there is no suggestion to combine the cited references, and because the cited combination does not teach or suggest all elements of the rejected claims.

## HELMBOLD IS NONANALOGOUS ART

“In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

Applicant submits that Helmbold is neither in Applicant's field of endeavor, nor reasonably pertinent to the particular problem with which Applicant is involved. Firstly, Helmbold describes a universal controller interface for barcode printers, whereas Applicant's claims relate to gaming machine memory. Moreover, the USPTO classified Helbold in the field of static presentation (358/1.15; 358/1.1; 358/1.13).

Secondly, Applicant submits that a gaming machine memory artisan would not look to barcode printer art for solving problems dealing with write protecting storage media for a gaming machine. Although Applicant is skilled in the art of gaming machines, Applicant does not claim to have the same level of skill in the barcode printer arts. As a result, Applicant “could not possibly be aware of every teaching in every art.” *In re Wood*, 559 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979). Thus, Applicant submits that an applicant having ordinary skill in the art of gaming machine memories would not consider barcode printer art as reasonably pertinent to gaming machine memory problems.

Thirdly, the MPEP's discussion of nonanalogous art in the electrical arts is instructive. According to MPEP §2141.01(a), the Court of Appeals for the Federal Circuit (CAFC) held that a reference disclosing single in-line memory modules (SIMMs) for an industrial controller was not in the same field of endeavor as claimed subject matter relating to SIMMs for use in personal computers. See MPEP §2141.01(a). The reference was “in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories.” *Id.* Because the CAFC has ruled that a reference about industrial controller SIMMs was nonanalogous art vis-à-vis claims to personal computer SIMMs, Applicant submits that Helmbold's barcode printer control interface reference is nonanalogous art vis-à-vis Applicant's gaming machine memory claims.

## NO SUGGESTION TO COMBINE OZEKI, HELMBOLD AND YOKOUCHI

The Office Action has improperly combined Ozeki with Helmbold and Yokouchi. For a proper combination, the Office Action must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *In re Fine*, F.2d 1071, 1074, 5 USPW2d 1596, 1598 (Fed. Cir. 1988).

The *Fine* court stated,

Obviousness is tested by “what the combined teaching of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (emphasis in original).

Ozeki describes techniques for write protecting a memory card of a gaming machine, whereas Helmbold teaches a barcode printer memory circuit and Yokouchi teaches that a write control signal can be inactive and access to SRAM, mask ROM, and the like can also be inhibited. The Office Action asserts that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to block the load signal as taught by Helmbold by disabling (deactivating) the load condition of the data register as taught by Yokouchi to the write protecting method of Ozeki in order to protect the protected data by disabling access to the memory device.” Office Action at Page 5, First partial paragraph. However, this assertion is unfounded, as the Office Action does not identify a single passage in any of the references that teaches or suggests combining Ozeki with Helmbold and Yokouchi. Furthermore, the Office Action does not provide a single reference identifying knowledge in the art that would serve as motivation to combine the cited references. Because there is no teaching or suggestion to combine the cited references, Applicant submits that the combination is improper. As such, Applicant requests withdrawal of the rejections under 35 USC §103.

THE REFERENCES DO NOT TEACH OR SUGGEST ALL THE CLAIM ELEMENTS

*Discussion of Claim 1*

Claim 1 recites “if the selected address matches an address of the data register, disabling at least one of the one or more load conditions of the data register.” In rejecting claim 1, the Office Action admits, “Ozeki et al does not disclose disabling the load condition as claimed.” However, the Office Action asserts that Yokouchi discloses disabling the load condition of the data register at Abstract and Column 19, Lines 56-59. See Office Action at Page 5, First Partial Paragraph. The cited passages from Yokouchi state:

A single-chip microcomputer and electronic device using the same are ideally adapted for an electronic notebook, electronic dictionary and the like with a reduced overall system power consumption. The single-chip microcomputer to which are connected externally connected devices any one of which can be selected by a chip select signal executes program instructions. The single-chip microcomputer has a chip select signal output terminal which makes active and outputs a chip select signal selecting one of the externally connected devices. The single-chip microcomputer further has standby state setting means which outputs a standby state setting signal temporarily halting the execution of program instructions and control means for changing said chip select signal which is active to be inactive based on the standby state setting signal from the standby state setting means.

And

At this time, the write control signal (/WE), read control signal (/RE), and chip select signals (/CE0, /CE1 and /CE2) are inactive, and access to the SRAM 210 and mask ROM 220 and the like is inhibited.

Applicant respectfully submits that the Office Action has mischaracterized Yokouchi. The first passage describes halting the execution of program instructions and control means for changing a chip select signal. The second passage describes having an inactive write signal and additionally having no access to SRAM, ROM and the like. However, these passages do not mention *load conditions of a data register*, much less teach or suggest the claimed “disabling at least one of the one or more load conditions of the data register.” Emphasis added. Applicant submits that neither of these passages teach disabling load conditions of any register. For the combination of Ozeki, Helmbold, and Yokouchi to teach or suggest each and every element of claim 1, Helmbold must teach or suggest what Ozeki and Yokouchi are lacking. As noted in the

Applicant's Response to the Office Action mailed December 30, 2004, Helmbold does not teach or suggest the claimed "disabling at least one of the one or more load conditions of the data register." Therefore, the combination of Ozeki, Helmbold, and Yokouchi does not teach or suggest each and every element of claim 1.

*Discussion of Claims 9, 14, 23, 27, and 29*

Independent claims 9, 14, 23, 27, and 29 each include features similar to those noted in the discussion of independent claim 1. For at least the reasons noted above, Applicant respectfully submits that the combination of Ozeki, Helmbold, and Yokouchi does not teach or suggest each and every element of dependent claims 9, 14, 23, 27, and 29.

*Discussion of Claims 2-4, 10-12, 15-20, 24-26, and 28*

Claims 2-4, 10-12, 15-20, 24-26, and 28 each depend, directly or indirectly, on one of independent claims 1, 9, 14, 23, and 27. For at least the reasons noted above, Applicant submits that the combination of Ozeki, Helmbold, and Yokouchi does not teach or suggest every element of dependent claims 2-4, 10-12, 15-20, 24-26 and 28.

*Reservation of Rights*

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art. Applicant also reserves the right to pursue canceled and originally filed claims in a continuation application. Furthermore, Applicant does not acquiesce to any of the Examiner's assertions about the claims or the cited documents and reserves the right to argue these assertions in the future.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 281-213-8980 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of October, 2005.

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